

Application No. 10/074,597
Response "C" dated May 31, 2005
Reply to Office Action mailed December 28, 2004

REMARKS

The Applicant's counsel wishes to thank the Examiner for the time spent in reviewing the application and preparing the Office Action. In the Office Action, claims 1, 2, 4-16 and 34-51 were rejected. By this paper claims 1-2, 4-16, and 34-51 are pending. Reconsideration of the above-identified claims is now respectfully requested.

Rejections Under 35 U.S.C. § 103

In the Office Action, claims 1, 2, 4-13, 15-16, 34 and 41 were rejected under 35 U.S.C. § 103 in view of U.S. Patent No. 3,968,620 by Keltner ("Keltner"), and claims 42-50 were rejected under 35 U.S.C. § 103 in view of the Keltner patent and U.S. Patent No. 5,476,184 by Hill ("Hill").

The Keltner patent fails to teach or suggest the claimed invention.

The Keltner patent relates to a packaged article for use as a "delightful and unusual gift" wherein the article "pop[s] out of a box" and "is very surprising and pleasing to one who unsuspectingly opens the box" (see col. 2, ll. 41-44). The article, such as a pillow, is compressed by placing it in a flexible plastic bag and thereafter removing excess air therefrom. Once sufficiently compressed, the article and associated bag are secured to prevent the article from inadvertently regaining its original size and shape (see col. 1, l. 55-col. 4, l. 37). The bag may be secured by either: (i) sealing the article and bag in a box (col. 2, ll. 29-31); (ii) placing the article and bag in a closed container, such as a canister (col. 2, ll. 59-61); or (iii) in the case of using a decorative plastic bag as the complete packaging, a tie around the opening of the bag can secure the bag (col. 2, ll. 57-59).

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In the Office Action, the Examiner states that "Keltner teaches the chair (1) in the vacuum chamber (3) can be placed in a container that is air permeable after compression (see col. 2, lines 61-63)." However, lines 61-63 of Column 2 state that "[a]fter compression, it is not necessary for either the bag or the container to be air-tight" (col. 1, ll. 61-63). A container that is not air-tight is not synonymous with a container comprising an air permeable or fabric material, such as a duffle or cotton bag.

Furthermore, the Keltner patent neither teaches nor suggests a storage container comprising an air permeable material, as required by Claims 1 and 34. The Keltner patent fails to teach or suggest this concept. The Keltner patent teaches that "it is not necessary for either the bag or the container to be air-tight" (col. 1, ll. 61-63). However, this teaching does not suggest that the storage container should comprise an air permeable material. It simply suggests that it is not necessary for either the bag or container to be air-tight. The Keltner patent is not clear as to the type of material the container can be made of. As such, there is no teaching or suggestion in the Keltner patent for a storage container comprising an air permeable material, as articulated in Claims 1 and 34.

The claims are not obviated by Keltner and/or Hill.

Additionally, in claims 1 and 34 the Applicant claims a vacuum chamber that has an opening, and a storage container that comprises an air permeable material. Thus, the Applicant at least claims a packaged furniture assembly having both an air permeable material and a vacuum chamber having an opening. The Keltner patent, on the other hand, only discloses that it is not necessary for the bag or container to be air-tight. There is therefore no teaching, suggestion or motivation by Keltner to employ both a vacuum chamber having an opening and a

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storage container comprising an air permeable container. Similarly, regarding claims 42-50, there is no teaching, suggestion or motivation by Keltner and/or Hill to employ both a vacuum chamber having an opening and a duffle bag, fabric bag or cotton bag.

According to section 2143.01 of the Manual of Patent Examining Procedure, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (emphasis in original). There is nothing in the Keltner reference that suggests the desirability of using both a vacuum chamber having an opening and a storage container comprising an air permeable material. Furthermore, it is not permissible to use hindsight when making a determination of patentability. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP § 2143.

As recited in the Applicant's patent application "because bag 44 is air permeable and because opening 28 of vacuum chamber 26 is still left partially open, chair 14 may continue to expand." Published application paragraph 0059. The opening of the vacuum chamber allows a unique expansion potential rather than sealing the chair or other article within the vacuum chamber, and the air permeable material allows the expansion of the combined vacuum chamber and chair. As further stated in the Applicant's disclosure, "leaving vacuum chamber 26 open to the atmosphere during storing and/or transportation significantly increases the eventual rate of expansion of chair 14, allowing the user to enjoy the uses of chair 14 more quickly after removing the storage container and vacuum chamber." Published application paragraph 0070.

Along similar lines, the Applicant submits that no suggestion or motivation exists in Keltner or Hill to combine their teachings to form the packaged furniture assemblies as

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articulated in claims 42, 45 and 48. In particular, the use of a bag as taught by Hill in conjunction with the teachings of Keltner would render Keltner unsatisfactory for at least one of its intended purpose. As mentioned above, the Keltner patent is directed at a packaged article for use as a "delightful and unusual gift" wherein the article "pop[s] out of a box" and "is very surprising and pleasing to one who unsuspectingly opens the box" (see col. 2, ll. 41-44). However, the bag (10) as illustrated by Hill includes zippers (28, 30) to close the top of the bag (10). The zippers (28, 30) as utilized in connection with the bag (10) would likely prevent an article from popping out of the bag (10). Use of the zippers (28, 30) to open the bag (10) is a process that would likely cause any compressed article contained therein to slowly escape from the bag (10), rather than pop out of the bag and surprise the opener. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). As such, because use of the bag of Hill would cause the article to slowly escape from the bag rather than surprisingly pop out of the bag, there is no motivation or suggestion to combine the teachings of Hill and Keltner to make the claimed invention as articulated in claims 42, 45 and 48.

The use of a vacuum chamber having an opening therein and an air permeable material, along with the additional elements claimed, renders the furniture significantly more useful than objects packaged with other elements. The Applicant's assemblies are nonobvious, unique and novel and are entitled to patent protection.

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Notice of Allowance in Divisional Application

Finally, enclosed for the Examiner's consideration are documents which pertain to an application that is a divisional of the present patent application, U.S. Patent Application No. 10/662,962 filed on September 15, 2003, copies of which are as follows: (i) office actions dated 12/03/2004 and 07/02/2004; (ii) the Notice of Allowance and Fee(s) Due, dated May 18, 2005; (iii) the Notice of Allowability and Examiner's Amendment, dated May 12, 2005; and (iv) an Examiner-Initiated Interview Summary.

Conclusion

Reconsideration and allowance of the above-identified claims is now respectfully requested. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

DATED this 31 day of May 2005.

Respectfully submitted,



Michael M. Ballard
Registration No. 54,978
Attorney for Applicant
Customer No. 022913
Telephone No. (801) 533-9800

DBD:MMB:jbc
MMH0000000121V001



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NOTICE OF ALLOWANCE AND FEE(S) DUE

022913 7990 05/18/2005
 WORKMAN NYDEGGER
 (F/K/A WORKMAN NYDEGGER & SEELEY)
 60 EAST SOUTH TEMPLE
 1000 EAGLE GATE TOWER
 SALT LAKE CITY, UT 84111

EXAMINER

HUYNH, LOUIS K

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 05/18/2005

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/662,962 | 09/15/2003 | Shawn Nelson | 15605.1.1 | 1090 |

TITLE OF INVENTION: PACKAGED FURNITURE ASSEMBLY AND METHOD THEREOF FOR COMPRESSIBLE FURNITURE

| APPLN. TYPE | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE |
|----------------|--------------|-----------|-----------------|------------------|------------|
| nonprovisional | NO | \$1400 | \$300 | \$1700 | 08/18/2005 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.



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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/662,962 | 09/15/2003 | Shawn Nelson | 15605.1.1 | 1090 |
| 077913 | 7590 | 05/18/2005 | EXAMINER | |
| WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111 | | | HUYNN, LOUIS K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3721 | |

DATE MAILED: 05/18/2005

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
 (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

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| | | | |
|-------------------------------|-----------------|---------------|--|
| Notice of Allowability | Application No. | Applicant(s) | |
| | 10/662,962 | NELSON, SHAWN | |
| | Examiner | Art Unit | |
| | Louis K. Huynh | 3721 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

- ☒ This communication is responsive to the RCE and the remarks filed on May 03, 2005.
- ☒ The allowed claim(s) is/are 1-4 and 7-20.
- ☒ The drawings filed on 15 September 2003 are accepted by the Examiner.
- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - ☐ All
 - ☐ Some*
 - ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

- ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
- ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
- ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

| | |
|---|--|
| Attachment(s) | |
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date <u>05122005</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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Art Unit: 3721

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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with Mr. David Dellenbach (Reg. 39,166) on May 11, 2005. See attached Interview Summary.
3. The application has been amended as follows:

In Claim 12:

"connecting" (line 7) has been changed to: --placing--;

"the furniture assembly" (line 9) has been changed to: --the compressed furniture assembly--.

In Claim 17::

the phrase: --to form a chair-- has been inserted between "bladder" and "such" on line 4;

the phrase: --placing the chair into a vacuum chamber having an opening;-- has been inserted between lines 5 and 6;

the phrase: --via said opening to compress the chair-- has been inserted between "vacuum source" and " ; " on line 6;

"the chair" (line 7) has been changed to: --the compressed chair--.

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4. The following is an examiner's statement of reasons for allowance:

With respect to Claim 17, the prior art of record fails to disclose and/or teach a method for manufacturing and packaging a chair that comprises in combination the steps of: placing the chair into a vacuum chamber having an opening, suctioning air from the chair with a vacuum source via the opening to compress the chair, and placing the compressed chair in a storage container that comprises a fabric material.

With respect to Claim 12, the prior art of record fails to disclose and/or teach a method for packaging a chair that comprises in combination the steps of: forming a furniture assembly comprising a chair disposed inside a vacuum chamber having an opening, placing the vacuum chamber in communication with a vacuum source, compressing the chair using the vacuum source, and with the opening of the vacuum chamber unsealed, placing the compressed furniture assembly in a storage container that comprises a fabric material.

With respect to Claim 1, the prior art of record fails to disclose and/or teach a method for packaging a chair that comprises in combination the steps of: placing a chair comprising an air permeable bladder and a filler material in a vacuum chamber, removing a substantial amount of air from the chair, allowing the chair to partially refill with air, placing the chair and vacuum chamber in a storage container having an opening, closing the opening of the storage container so that a plume extends therefrom, and applying adhesive to the inside of the plume to seal the opening of the storage container.

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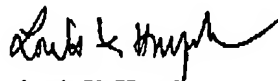
5. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (571) 272-4462. The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi L. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 12, 2005


Louis K. Huynh
PRIMARY EXAMINER
Art Unit 3721

| Examiner-Initiated Interview Summary | Application No. | Applicant(s) | |
|---|----------------------------|------------------|--|
| | 10/662,962 | NELSON, SHAWN | |
| | Examiner Louis K. Huynh | Art Unit 3721 | |

All Participants: **Status of Application:** RCE

(1) Louis K. Huynh. (3) _____

(2) Mr. David Dellebach (Reg. No. 39,166). (4) _____

Data of Interview: _____ **Time:** _____

Type of Interview:

☒ Telephonic

☐ Video Conference

☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Exhibit Shown or Demonstrated: ☐ Yes ☒ No

If Yes, provide a brief description:

Part I.

Rejection(s) discussed:

Claims discussed:

12 and 17.

Prior art documents discussed:

Part II.


SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

See Continuation Sheet

Part III.

☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.

☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.


(Examiner/SPE Signature)

(Applicant/Applicant's Representative Signature - if appropriate)

Continuation Sheet (PTOL-413B)

Application No. 10/662,952

Continuation of Substance of Interview including description of the general nature of what was discussed:

The examiner proposed, and agreed to by applicant's attorney, to amend claims 12 and 17 in order to clearly define the claimed invention over the prior art of record and to place the application in condition for allowance.

The attorney, Mr. David Dellenbach, as a part of the duty to disclose information, has mentioned a similar rejection of the article claim groups in the parent application Ser. No. 10/074,597 using the same prior art: US Pat. No. 3,968,620 and US Pat. No. 5,476,184. However, the parent application and the present divisional application each has its own merits and each is examined on such merits. The patentability of one application does not depend on the patentability of the other since they are drawn to different and independent inventions.



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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/662,962 | 09/15/2003 | Shawn Nelson | 15605.1.1 | 1090 |
| 22913 | 7390 | 12/03/2004 | EXAMINER | |
| WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111 | | | HUYNH, LOUIS K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3721 | |
| DATE MAILED: 12/03/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|-----------------|---------------|--|
| Application No. | Applicant(s) | |
| 10/662,962 | NELSON, SHAWN | |
| Examiner | Art Unit | |
| Louis K. Huynh | 3721 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1-4 and 7-11 is/are allowed.
6) ☒ Claim(s) 12-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/27/04
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 12 and 17 in paper filed September 27, 2004 have been considered but are moot in view of the new ground(s) of rejection below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keltner (US 3,968,620).

With respect to Claim 12, Keltner discloses a method for packaging a chair including the steps of: forming furniture assembly by providing an article (1) comprising an air permeable bladder (cloth fabric cover) filled with light density flexible polyurethane foam and placing the article in a vacuum chamber (plastic bag 3); connecting the vacuum chamber in communication with a vacuum source (col. 2, lines 7-17); compressing the article using the vacuum source (col. 2, lines 17-20); placing the furniture assembly in a storage container (2) with the vacuum chamber unsealed (col. 2, lines 29-32). Note that the article used in the method of Keltner is foam chair or couch (col. 2, lines 64-68). The method of Keltner meets all of applicant's claimed subject matter but lacks the specific teaching of the storage container comprising an air permeable material. However, Keltner teaches that the article (1) in the vacuum chamber (3) can be placed in a container which is air permeable after compression (col. 2, lines 61-63). Therefore,

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it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have provided the method of Keltner with an air permeable container including a container that is made of air permeable material to contain the article (1) for as long as the container prevents the article from popping out un-intentionally.

With respect to Claim 13, the modified method of Keltner meets all of applicant's claimed subject matter but lacks the specific teaching of a step of connecting the vacuum chamber in communication with a high-powered vacuum source. However, Keltner discloses that higher volume reductions may be obtained with further pressure reductions (col. 3, lines 23-24); therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have modified the method of Keltner by having connected the vacuum chamber with a higher powered vacuum source, as suggested by Keltner, in order to further reduce the volume of the article thus saving storage space.

With respect to Claims 14 and 15, the article (1) is compressed to less than 20% of its original volume (col. 1, lines 56-64) which meets the limitations as claimed in Claims 14 and 15.

With respect to Claim 16, Keltner further discloses a step of removing the packaged furniture assembly from the storage container and removing the article from the vacuum chamber, wherein the chair refills to substantially the original volume after removal from the vacuum chamber (col. 2, lines 38-40).

With respect to Claim 17, Keltner discloses a method for manufacturing and packaging an article (1) including the steps of: providing an air permeable bladder (cloth fabric cover); placing a filler material (light density flexible polyurethane foam) within the air permeable bladder; suctioning a substantial amount of air from the article with a vacuum source (col. 2,

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lines 7-20); and placing the furniture assembly in a storage container (2) with the vacuum chamber unscaled (col. 2, lines 29-32). Note that the article used in the method of Keltner is foam chair or couch (col. 2, lines 64-68). The method of Keltner meets all of applicant's claimed subject matter but lacks the specific teaching of the storage container comprising an air permeable material. However, Keltner teaches that the article (1) in the vacuum chamber (3) can be place in a container which is air permeable after compression (col. 2, lines 61-63). Therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have provided the method of Keltner with an air permeable container including a container that is made of air permeable material to contain the article (1) for as long as the container prevents the article from popping out un-intentionally.

With respect to Claim 18, the modified method of Keltner includes the step of placing the article (1) in an air permeable storage container in which the article is allowed to partially refill with air while in the air permeable storage container (col. 2, lines 29-32).

4. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keltner (US 3,968,620) in view of Hill (US 5,476,184).

The modified method of Keltner meets all of applicant's claimed subject matter but lacks the specific teaching of the storage container comprising a duffle bag or an air permeable, pliable, cotton bag. However, Keltner teaches that the article (1) in the vacuum chamber (3) can be place in a container which is air permeable after compression (col. 2, lines 61-63). Hill discloses such air permeable container that comprises an outer duffle bag shell (10) and collapsible insert (12, 14, 16) that keeps the duffle bag in the form of a box. It would have been

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obvious to an ordinary skilled person in the art, at the time the invention was made, to have provided the duffle bag of Hill in the modified method of Keltner since such duffle bag meet the requirement of a container that is not airtight. Note that duffle bag is known to be fabricated from air permeable and pliable cotton.

Allowable Subject Matter

5. Claims 1-4 and 7-11 are allowed over the prior art of record. Specifically, the prior art of record fails to disclose a method for packaging a chair comprising in combination as recited in claim 1 and including the step of sealing the storage container by applying adhesive to the inside of the plume formed at the opening of the storage container.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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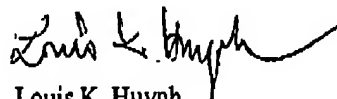
Page 6

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (571) 272-4462.

The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Louis K. Huynh
Primary Examiner
Art Unit 3721

November 29, 2004



UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/662,962 | 09/15/2003 | Shawn Nelson | 15605.1.1 | 1090 |
| 22913 | 7590 | 07/02/2004 | EXAMINER | |
| WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111 | | | HUYNH, LOUIS K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3721 | |
| DATE MAILED: 07/02/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/662,862 | NELSON, SHAWN | |
| | Examiner | Art Unit | |
| | Louis K. Huynh | 3721 | |

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 15 September 2003.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-5 and 8-18 is/are rejected.

7) ☐ Claim(s) 6 and 7 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/18/03 & 10/2/03

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

U.S. Patent and Trademark Office
PTOL-326 (Rev. 1-04)

Office Action Summary

Part of Paper No./Mail Date 06282004

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DETAILED ACTION***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, line 1: "the storage container" lacks proper antecedent basis. Perhaps, Claim 5 should depend on Claim 4.

Claim 12, line 1: "and shipping a chair" renders the scope of the claim indefinite for the step of shipping is not set forth in the body of the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 5, 8-12, 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Keltner (US 3,968,620).

With respect to Claim 1, Keltner discloses a method for packaging a chair including the steps of: providing an article (1) comprising an air permeable bladder (cloth fabric cover) filled with light density flexible polyurethane foam; placing the article in a vacuum chamber (plastic bag 3); removing a substantial amount of air from the article (col. 2, lines 7-20); allowing the

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article to partially refill with air by simply taping or tying opening of the vacuum chamber to create a partial opening for the vacuum chamber (col. 2, lines 32-37). Note that the article used in the method of Keltner is foam chair or couch (col. 2, lines 64-68).

With respect to Claim 2, air is removed by suctioning the air from the article using a vacuum source in the method of Keltner (col. 2, lines 7-17).

With respect to Claims 4 & 5, the method of Keltner further includes a step of placing the vacuum chamber with the article therein into a storage container (2) having flaps (8) for sealing the opening of the storage container; and a step of sealing the storage container by sealing the flaps (8); and wherein the vacuum chamber (3) is allowed to remain partially open after the article and the vacuum chamber are placed in the storage container (2) (col. 2, lines 29-37).

With respect to Claims 8-11, the article (1) is compressed to less than 20% of its original volume (col. 1, lines 56-64) which meets the limitations as claimed in Claims 8-11.

With respect to Claim 12, Keltner discloses a method for packaging a chair including the steps of: forming furniture assembly by providing an article (1) comprising an air permeable bladder (cloth fabric cover) filled with light density flexible polyurethane foam and placing the article in a vacuum chamber (plastic bag 3); connecting the vacuum chamber in communication with a vacuum source (col. 2, lines 7-17); compressing the article using the vacuum source (col. 2, lines 17-20); placing the furniture assembly in a storage container (2) with the vacuum chamber unsealed (col. 2, lines 29-32). Note that the article used in the method of Keltner is foam chair or couch (col. 2, lines 64-68).

With respect to Claims 14 and 15, the article (1) is compressed to less than 20% of its original volume (col. 1, lines 56-64) which meets the limitations as claimed in Claims 14 and 15.

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With respect to Claim 16, Keltner further discloses a step of removing the packaged furniture assembly from the storage container and removing the article from the vacuum chamber, wherein the chair refills to substantially the original volume after removal from the vacuum chamber (col. 2, lines 38-40).

With respect to Claim 17, Keltner discloses a method for manufacturing and packaging an article (1) including the steps of: providing an air permeable bladder (cloth fabric cover); placing a filler material (light density flexible polyurethane foam) within the air permeable bladder; and suctioning a substantial amount of air from the article with a vacuum source (col. 2, lines 7-20). Note that the article used in the method of Keltner is foam chair or couch (col. 2, lines 64-68).

With respect to Claim 18, the method of Keltner further includes the step of placing the article (1) in a storage container (2) wherein the article is allowed to partially refill with air while in the storage container (col. 2, lines 29-32) and is allowed to refill with air when removed from the storage container (col. 2, lines 38-40).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keltner (US 3,968,620).

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7. The method of Keltner meets all of applicant's claimed subject matter but lacks the specific teaching of a step of connecting the vacuum chamber in communication with a high-powered vacuum source. However, Keltner discloses that higher volume reductions may be obtained with further pressure reductions (col. 3, lines 23-24); therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have modified the method of Keltner by having connected the vacuum chamber with a higher powered vacuum source, as suggested by Keltner, in order to further reduce the volume of the article thus saving storage space.

Allowable Subject Matter

8. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure has been cited on form PTO-892 along with the applied prior art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (703) 306-5694.

The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

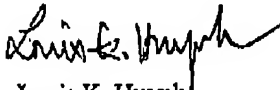
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Louis K. Huynh
Patent Examiner
Art Unit 3721

June 28, 2004

FILED VIA FACSIMILE

PATENT APPLICATION

Docket No.: 15605.1

RECEIVEDIN THE UNITED STATES PATENT AND TRADEMARK OFFICE **CENTRAL FAX CENTER**

In re application of: Shawn Nelson)

Serial No.: 10/074,597)

Confirmation No.: 4845)

Filed: February 11, 2002)

For: PACKAGED FURNITURE ASSEMBLY AND
METHOD THEREOF FOR COMPRESSIBLE
FURNITURE)

Examiner: Stephen A. Vu)

MAY 31 2005Art Unit
3636

NOTIFICATION OF LOSS OF ENTITLEMENT TO SMALL
ENTITY STATUS PURSUANT TO 37 C.F.R. § 1.27(g)

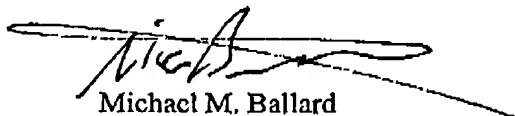
Via Facsimile (703) 872-9306
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby notifies the Patent and Trademark Office that it is no longer entitled to status as a small entity and that the previous claim for small entity status is hereby withdrawn.

Dated this 31 day of May 2005.

Respectfully submitted,



Michael M. Ballard
Registration No. 54,978
Attorney for Applicants
Customer No. 022913
Telephone No. (801) 533-9800
mballard@wnlaw.com

MMB:jba
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